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09/975,649	10/11/2001	James R. Edgar	87801-9015-00	8597

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ESTREMSKY, GARY WAYNE

ART UNIT	PAPER NUMBER
	3677

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/975,649	Applicant(s) Edgar
	Examiner Estremsky	Art Unit 3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.
- Disposition of Claims**
- 4) Claim(s) 1-68, 70-82, 84-92, and 94-113 is/are pending in the application.
- 4a) Of the above, claim(s) 9, 25, 37-55, 61-63, and 79 is/are withdrawn from consideration.
- 5) Claim(s) 29-36, 81, 82, 84-92, and 94-113 is/are allowed.
- 6) Claim(s) 1-8, 10-24, 26-28, 56-59, 64-68, 70-78, and 80 is/are rejected.
- 7) Claim(s) 60 is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on Jul 21, 2003 is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) The translation of the foreign language provisional application has been received.

- 15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121. _____

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) Other: _____

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DETAILED ACTION

Opening Remarks

1. Claims 9, 25, 37-55, 62, 63, 79, 91, 96, and 104 include limitations that are inconsistent and/or directly contrary to features of the elected embodiment and are apparently drawn to a non-elected embodiment of the invention. It is the examiner's position that the disclosure does not provide adequate support to allow clear or proper interpretation of these claims as regards the elected embodiment. Inasmuch as the claims are drawn to a non-elected embodiment, they have been withdrawn from further consideration rather than rejected under 35 USC 112, first and/or second paragraph.

In the course of examination, it was determined that claims 83, 91, 96, and 104 (drawn to non-elected embodiment(s)) are dependent from allowable claims. Consequently, election of species requirement with respect to those claims is withdrawn, the claims rejoined and allowed hereinbelow.

Accordingly claims 1-8, 10-24, 26-36, 56-61, 64-68, 70-78, 80-92, 94-113 are currently pending and examined hereinbelow.

Information Disclosure Statement

2. The information disclosure statements filed 3/1/02 and 7/8/02 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that

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portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Applicant's arguments and copy of post card receipt are noted. However, copies of the foreign references have not been provided and cannot be fully considered due to inaccuracies in the reference citations or other problems in obtaining copies of the documents. It is requested that Applicant provide copies of those references for consideration and for attachment as part of the record.

Drawings

3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on July 21, 2003 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of a 'square' indicated in dashed lines as the necessary and only construction/location of the claimed "stop". It is suggested that a more schematic illustration could be entered assuming it does not include details of structure or arrangement beyond that explicitly described by the original written description.

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4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
 - a. Claim 1 for example requires; a “first lever”, “second lever” , “third lever”.
 - b. Claim 94 for example includes “at least one stop” that is not illustrated.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-8, 10-24, 26-28, 68, and 70-80 and their dependent claims are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As regards claim 1, 17, 68 and dependents thereof, the original written description and Figures do not describe a “first lever”, “second lever”, and “third lever” in the detail required for

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one of ordinary skill in the art to make and use the invention as now claimed. It is noted that a ‘second *element*’ is disclosed but it does not read on more specific limitation of “lever”.

lever >noun 1 a rigid bar resting on a pivot, used to move a load with one end when pressure is applied to the other. 2 a projecting arm or handle that is moved to operate a mechanism.

As regards limitation of “is translatable to the two different positions” and “is rotatable to the two different positions” (claims 6, 7 for example), as disclosed, the elected embodiment is only capable of movement through an integral combination of translation and rotation. As regards scope of the invention, plain meaning of these more exclusive limitations are distinguished from limitations that ‘include’ translating or that ‘include’ rotating movement.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-8, 10-24, 26-28, 68, and 70-80 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As regards claims 1, 17, 68 and dependents therefrom, since the disclosed embodiment elected for prosecution does not appear to include “first”, “second”, and “third lever”, arranged as set forth in the claim, it is not clear how the claim should or can be interpreted with respect to the elected embodiment.

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Additionally as regards claims 6 and 7 for example, plain meaning or interpretation of the scope of the limitations “*is* translatable” and “*is* rotatable”, require *only* ‘translation’ and *only* ‘rotation’ respectively. In a similar way, if an object is black and white, it would be inaccurate and/or misleading to say it ‘is black’ or ‘is white’. As best understood, the term --including-- should be inserted since the elected embodiment of the invention can only be moved using a combination of translatory and rotational movement.

Additionally regarding claim 15, ‘circular’ causation of movement described in the claim does not appear to be consistent with the written description and/or meaningful, i.e., ‘the third lever is able to be moved by camming interaction with the second lever that is caused by the rotational movement of the third lever’ seems to require perpetual motion. It is not clear what is covered by the actual limitation.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-8, 10, 12-15, 17-19, 21-24, 26, 28, 56-59, 61, 64-68, 70-78, and 80 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,277,461 to Dzurko.

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Dzurko '461 teaches Applicant's claim limitations including : a "housing" - 21, a "ratchet" - 30, a "pawl" - 32, a "first lever at least partially located in the housing and movable to two different positions with respect to the pawl" - 34, "the lever having a pivot point,...,substantially the same location with respect to the lever in both of the two different positions" - 36, "third lever" - either of levers 80,82 read on limitation. Written description of the "LOCKING MECHANISM" in the reference explicitly teaches other more functional portions of the claim.

See MPEP 2114.

It should be noted that locking/unlocking positions of part 34 are pivotal with respect to part 36 and that pushing part 48 down for unlatching also causes some amount of rotation of part 34 about 36.

As regards claims including 2 and 3, limitation of "additional positions" is broad enough to be anticipated by any position of the continuum of positions between end positions, where the examiner points out that due to the geometry disclosed, the lever 34 will inherently be unlocked and capable of opening the pawl just prior to reaching the extreme end position described as an 'unlocked position'.

As regards interpretation of claims 6-8, lever 34 is inherently capable of pivotally moving between locked/unlocked positions during an essentially translatory unlatching movement whereby the lever is inherently capable of moving "by a combination of rotation and translation of the lever". As regards claim 6, although the lever does not move through translation without

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rotation, the limitation is interpreted more broadly in accordance with Applicant's arguments in order to expedite prosecution.

As regards claim 10, either of levers 80,82 read on relatively broad limitation of "rotatable element".

As regards claim 13; part 56 reads on limitation of "rotatable element" and part 40 reads on limitation of "link".

As regards claim 17, limitations read on pivoting of lever 34 by an operator using a handle while the latch mechanism is in the locked position, unlocking the latch with either of levers 80,82, and unlatching the pawl by operation of lever 34 by an operator using a handle, respectively.

As regards claim 18, the continuum of pivot positions inherent to structure of the reference is discussed above.

As regards claim 26, lever 40 is used to move 34 between a locked and unlocked positions.

Similar to above as regards claim 56, part 34 reads on "lever" and part 40 reads on "rotatable member" where due to the geometry of the levers of the reference and the continuum of positions discussed above, the latch of the reference is inherently capable of the functional recitation so long as the movement of part 40 is early enough in an unlatching movement of part 34 that connection is made with the unlatching actuator. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the

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ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. See MPEP 2114.

Allowable Subject Matter

11. Claims 29-36, 81, 82, 84-92, and 94-113 are allowed.
12. Claim 60 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.
13. Due to the nature of rejections made under 35 USC 112, first paragraph, allowable subject matter cannot be indicated with respect to claims 11, 16, 20, 25, and 27.
14. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Arguments

15. Applicant's arguments that copies of the foreign references have been previously filed at the Patent Office are noted. However, any such references have not been entered into the file and cannot be considered. While U.S. patent documents are easily retrieved, that is not necessarily

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the case with the foreign documents, as referenced. It is requested that copies of those documents be provided to be made part of the record and to be considered during examination since they may be relevant as prior art.

Applicant's arguments regarding withdrawal of claims not readable on the elected embodiment are noted. Applicant argues that the withdrawn claims should be read on the elected embodiment since any lever (and accordingly, even the lever of the elected embodiment) has "mass" and therefore the withdrawn claim can be read on the elected embodiment. Admittedly, any lever has mass; but in that respect, even air has mass. But more importantly, Applicant's arguments do not address the more specific limitations such as "extended toward and adjacent to the pawl" and "disposed a distance away from the pawl", etc.. Those limitations are assumably specific to a non-elected embodiment of the invention but in any case, are not illustrated and described with respect to the elected embodiment of the invention. While a pawl is illustrated in Fig 2, none is illustrated in Fig's 1 or 3-7 corresponding to the elected embodiment.

It is in the interests of Applicant that all patent claims be enabled by a clear written description of the invention using the same terminology as the claims, and that the claims' language is clear and definite where all claim elements are illustrated by the Figures so as to allow the scope of protection afforded by the claims to be determined and enforced. In that respect, the examiner has made several suggestions to correct noted problems. It is suggested that, if this Application is Continued; the claims should be amended to clarify the scope of the invention to correspond with the disclosed embodiment that has been elected for prosecution.

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As regards the claimed invention and objections to the drawings and/or rejections made under 35 USC 112, first and/or second paragraph: wherever a claim explicitly sets forth an element as part of the arrangement thought to be the invention, it is assumed that Applicant is relying upon that element, at least within context of the claim, to patentably define from the prior art. The examiner acknowledges that a ‘spring’ or ‘electromagnet’ are not new structures and that Applicant does not have to illustrate what is old and well known in the art, but since the claims define what it is that Applicant believes to be ‘new’ and desires exclusive rights to, it is required that Applicant illustrate the elements of the claimed invention.

As regards rejection of claims 6 and 7 under 35 USC 112, first paragraph related to limitations of “is translatable to the two different positions” and “is rotatable to the two different positions” (claims 6, 7 for example); as disclosed, the elected embodiment is only capable of movement through an integral combination of translation and rotation. Claims 6 and 7 are not rejected “for not claiming a combination of translation and rotation” but for in effect, more specifically requiring *only* translation and *only* rotation, respectively, where only a combination of translation and rotation has been enabled. As discussed in the first Office Action and during the telephone interview, as regards scope of the invention, ‘plain meaning’ of these more exclusive limitations are distinguished from limitations that ‘include’ translating or rotating movement. If a car is black and white it would be misleading and/or confusing to say it ‘is a white car’ or that it ‘is a black car’ since plain meaning of the term “is” as used, denotes identity.

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As regards prior art rejections, the previous grounds of rejection have been carefully considered but due to amendments to the claims, what amounts to a new grounds of rejection , as detailed above, renders Applicant's arguments.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Submission of any response by facsimile transmission is encouraged. Group 3677's relevant facsimile number is :

(703) 872-9306 - for all formal communications to be entered into the Application.

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Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly within our examining group and will eliminate Post Office processing and delivery time and will bypass the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a Deposit Account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitted by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) ____ - ____) on _____
(Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is (703) 308 - 0494. The examiner can normally be reached on M - Th from 730 am to 600 pm.

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19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann, can be reached on (703) 306-4115.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

- Technology Center 3600 Customer Service is available at 703-308-1113.
- General Customer Service numbers are at 800-786-9199 or 703-308-9000.

GWE

October 20, 2003



GARY ESTREMSKY
PRIMARY EXAMINER